

Remarks

Claims 1-9 are pending in the application. Because the Amendment after Final Rejection mailed 10/21/05 was not entered, the applicant again respectfully amends claims 1 and 8 to clarify that the claimed sound dampening pad is in the form of a strip material having a finite length. Basis for the amendment may be found in the specification at page 6, paragraph [0025]. No new matter has been entered.

Claims 1-9 were newly rejected as being obvious under § 103(a) in light of Mahl (US 3,998,347), Caldwell (US 3,160,549), and Gold (US 5,150,943). Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to modify and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

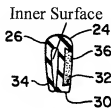
Claim 1 recites, *inter alia*, a sound dampening pad comprising a strip of flexible polymeric material having a finite length, and a generally curved J-shaped configuration when viewed from an end thereof. The sound dampening pad further comprises inner and outer surfaces, wherein the inner surface comprises the inner radius of the J-shaped configuration, and the outer surface comprises the outer radius of the J-shaped configuration. The inner surface further comprises a pressure sensitive adhesive thereon. Similarly, claim 8 recites, *inter alia*, a sound dampening pad having a finite length and a generally curved U-shaped configuration.

Mahl is cited for teaching an elastomeric ring 22 comprising a flexible polymeric material with a J-shaped configuration. Mahl is also cited for teaching a continuous ring having inner and outer surfaces, and an adhesive on the inner surface. As the examiner concedes, the Mahl ring is continuous. Thus, Mahl fails to teach using a strip of flexible polymeric material having a finite length as recited in the claims. Mahl also fails to teach sound dampening, a generally curved J-shaped configuration, or a pressure sensitive adhesive located on the inner surface.

To cure these noted deficiencies, the examiner adds the pressure sensitive adhesive of the Caldwell sound dampening member to the arrangement of Mahl. The examiner asserts it would have been obvious to make the combination, because the adhesive would provide ready-to-lay convenience to the Mahl arrangement. Caldwell fails to cure the teaching deficiencies of Mahl. For instance, Caldwell teaches flat vibration damping sheets, not a strip of flexible polymeric material having a finite length and a generally curved J-shaped or U-shaped configuration as claimed.

Recognizing these further deficiencies, the examiner consults a third reference, Gold, in an attempt to cure the deficiencies of Mahl and Caldwell. The Examiner states one skilled in the art would know to combine Gold with Mahl and Caldwell to enable the strip to match where it is being mounted. Gold is cited for teaching a U-shaped flexible elastomeric mounting material 24 configured to straddle the edge 22 of a van window opening. Despite the addition of Gold, the combination still fails to teach or suggest all elements of independent claims 1 and 8. No reference teaches a pressure sensitive adhesive located on the inner surface of a curved J or U-shaped configuration. Gold teaches a curved configuration, but fails to teach pressure sensitive adhesives, and also fails to teach placing adhesives on the inner surface of the curved

configuration. Referring to Fig. 3 below, the examiner points out that Gold teaches an adhesive (tape 36) on the *outer* surface of the mounting 24. There is no teaching that the tape 36 constitutes a pressure sensitive adhesive as recited in the claims, and the Gold adhesive 36 is not located on the inner surface of the mounting as recited in the claims.



Moreover, Gold teaches away from modifying the placement of the adhesive on the inside surface of the curved mounting, because it would render Gold inoperable for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The tape adhesive 36 of Gold is used to adhere the mounting 24 to a window 38. If the tape were placed on the inside surface of the mounting 24, the mounting 24 could not be adhered to a window 38. (col. 2, lines 26-27). As a result, modifying Gold, as the examiner proposed, would render Gold inoperable for its intended purpose. Accordingly, the cited references, singularly or in combination, fail to teach or suggest a curved configuration comprising an inner surface with a pressure sensitive adhesive thereon as recited in independent claims 1 and 8.

Furthermore, the references fail to provide any teaching or suggestion that would lead one of ordinary skill in the art to combine the teachings of the references. The examiner concedes that no reference discloses all elements of the claimed invention, so the examiner asserts that one skilled in the art, without any guidance from the prior art, would be led to

combine components from three non-analogous references in order to teach the claimed invention. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

The Mahl, Caldwell, and Gold references are situated in vastly different technologies, and thus are directed to vastly different problems. Clearly, bell jar seals as taught by Mahl, boat hulls, motor vehicle panels and airplane fuselage panels as taught by Caldwell, and van window portholes as taught by Gold, do not constitute the same field of endeavor. Also, these three non-analogous references are not directed to the problems to be solved in the present case i.e. sound dampening for printing sleeves used in flexographic printing. As a result, these references constitute non-analogous art and thus should not be asserted, or combined in the present rejection.

Due of the vastly different technology areas, none of the references explicitly provide a teaching or motivation to combine the references as the examiner proposes. Notwithstanding the lack of suggestion in the references, the examiner cites generalized principles to combine these references; however, these generalized principles would not lead one skilled in the art to combine Mahl and Caldwell as the examiner proposes. "One cannot base obviousness upon what a person skilled in the art might try or might find obvious but rather must consider what the prior art would have led a person skilled in the art to do." *In re Tomlinson*, 150 USPQ 623 (CCPA 1966). Mahl is combined with Caldwell for "ready-to-lay" convenience, which essentially means convenience and speed. However, it is unclear how "ready to lay" convenience would provide guidance to one skilled in the art to combine a bell jar seal with a pressure sensitive adhesive

from a motor vehicle panel or airplane fuselage panel. There is no suggestion in Mahl that a seal for a bell jar needs or would benefit from a pressure sensitive adhesive present in a vibration damping sheet used in an airplane fuselage panel, and there is no teaching that the combination would be successful. The only reasons to combine Mahl and Caldwell are luck or hindsight reconstruction, and neither of these constitutes a proper suggestion or motivation to combine.

Furthermore, the examiner combines Mahl and Caldwell with Gold by stating that the curved and bent shape would provide flexibility for the strip. Similar to above, flexibility is a general teaching, which would not lead one skilled in the art to incorporate a mounting from a vehicle window with a bell jar seal or a vibration damping sheet used in airplane fuselage panels, except as a result of happenstance or hindsight reconstruction.

Even if the Mahl, Caldwell, and Gold references were combined through impermissible hindsight reconstruction, the combination still fails to teach all elements of the claimed invention. The combination of Mahl, Caldwell, and Gold fails to teach a strip of finite length having a curved J or U-shaped inner surface comprising a pressure sensitive adhesive.

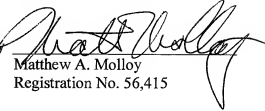
3Accordingly, the cited references fail to teach or suggest all elements of the claimed invention. Thus, independent claims 1 and 8 and all claims dependent thereon are in condition for allowance. Applicants respectfully submit that the application is now in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully requested.

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Respectfully submitted,

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